



6-23-04

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANTS: Shin-Ichi Yamaguchi et al.  
SERIAL NO. 10/032,741  
EXAMINER: John L. Goff II ART UNIT: 1733  
FOR: Manufacturing Method of Belt and Manufacturing Apparatus  
ATTORNEY DOCKET NO. 505500-62 Customer No. 27162

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria VA 22313-1450

**PETITION UNDER 37 CFR 1.181  
TO WITHDRAW FINALITY OF FINAL REJECTION AS PREMATURE**

SIR:

This is a petition seeking the supervisory authority of the Commissioner to reverse the holding of the Examiner denying applicants' request to withdraw the finality of the Final Office Action in the above-entitled application. Applicants filed a response to an Office Action dated September 10, 2003, on December 8, 2003. This petition refers to a Final Rejection dated March 10, 2004, a response to the final rejection filed April 26, 2004 and to a Request to Withdraw the Finality of the Final Rejection, and Advisory Action dated June 8, 2004 which issued as a result of those responses.

The claims were rejected in the prior Office Action of September 10.

Claim 2 was rejected under 35 USC 103 over Wood alone and in view of well known techniques that were characterized in the Office Action as obvious, but with no reference cited, and also over Ndebi et al. in view of Bliss and well known alternatives to using a pneumatic chamber, with no reference cited, in the Office Action of September 10,

2003. Claim 2 was not amended in the above noted response filed on December 8, 2003. Applicants in their response to the final rejection requested that a reference be cited showing what was deemed as well known.

The final Office Action dated March 10, 2004 then rejected claim 2 over Wood in view of Straughan and either one of Gansen or Bliss.

This is a new grounds of rejection not warranted by any amendment to the claims. Therefore, the finality of the Office Action of March 10, 2004, is premature and should be withdrawn. The Office issued an advisory action dated June 8, 2004 wherein it is stated that the citation of new references is not a new grounds of rejection merely because applicants requested that such be cited. The fact that applicants requested that a reference be cited is immaterial to the fact that there is a new issue raised as to the obviousness to combine these newly cited references. There is no showing in the final rejection of a suggestion in the references to combine them in the manner claimed. Merely because references individually teach various elements of a claimed combination, and this paper is not an admission that such new references make such a teaching, does not provide a showing of a teaching of the desirability of the combination. This requires a study of the new references and a linking of them in their disclosures to what is claimed. This becomes a new ground of rejection to which applicant should have an opportunity to respond with amendment to the claims and to continue prosecution. This is an undue burden on applicants. The denial is in error and should be reversed.

The Examiner misconstrued the term "laminated" in the original filed claims and requested this term be deleted in the September 10 Action. Applicants complied and substituted the word "composite" intending this to mean the same wherein the term laminated is used in the specification. Now in the Advisory Action the Examiner explains

the term "composite" does not mean the same as the term "laminated" and therefore rejects the argument in the final rejection response.

To add the term laminated at this time was indicated by the Examiner's supervisor Mr. Afterguf as requiring a new search and would not be entered. This position exalts form over substance. Applicants should be able to reinsert the term "laminated" at this time as it does not raise new issues as asserted by Mr. Afterguf because the term was in the claims as originally presented and thus should have been searched at that time. The Examiner's error in misconstruing the term "laminated" initially in the first Office Action in view of its explicit use in the as filed specification should not form a basis for not entering such an amendment at this time, which was indicated to be the result in a telephone interview with Mr. Afterguf. Therefore, the finality of the final rejection should be withdrawn so that an amendment to the claims may be entered as discussed herein.

Enclosed is a request for a one month extension of time and a check in the amount of \$110 for the extension. The Commissioner is authorized to charge payment of any fees associated with this communication or credit any overpayment to Deposit Account No. 03-0678.

**EXPRESS MAIL CERTIFICATE**

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Deposit Date: June 21, 2004

I hereby certify that this paper and the attachments hereto are being deposited today with the U.S. Postal Service "Express Mail Post Office To Addressee" service under 37 CFR 1.10 on the date indicated above addressed to:

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William Squire  
June 21, 2004  
Date

#214876v2

Respectfully submitted,  
Shin-Ichi Yamaguchi et al.

  
William Squire, Esq.

Reg. No. 25,378

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